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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. [redacted] 118

ERNST JOHAN JENS HENRIKSEN and W. A. SHEAFFER PEN COMPANY, *Petitioners*

v.

CORY CORPORATION, *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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INDEX

	Page
Opinions Below	2
Jurisdiction	2
Questions Presented	2
Patent Office Rule and Commissioner's Order Involved	3
Statement of the Case	4
Reasons for Granting the Writ	12
Conclusion	30
Appendix	1a

CITATIONS

CASES:

Berry Bros. Corp. v. Sigmon, 317 F.2d 700 (1963)	14
Bianchi v. Barili, 168 F.2d 793 (1948)	21
Cammeyer v. Newton, 94 U.S. 225 (1876)	27
Champlin Refining Co. v. Corporation Commission of Oklahoma, 286 U.S. 210 (1932)	28
Connally v. General Construction Co., 269 U.S. 385 (1926)	28
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405 (1908)	27
Del Francia v. Stanthony Corp., 278 F.2d 745 (1960)	20
Directoplate Corp. v. Donaldson Lithographing Co., 51 F.2d 199 (1931)	20-1
Doble Engineering Co. v. Leeds & Northrup Co., 134 F.2d 78 (1943)	20
Dwight & Lloyd Sintering Co. v. Greenewalt, 27 F.2d 823 (1928)	24, 30
Edward Valves, Inc. v. Cameron Iron Works, 286 F.2d 933 (1961)	14
Electric Storage Battery Co. v. Shimadzu, 123 F.2d 890 (1941)	21

Page

Engelhard Industries, Inc. v. Research Instrument Corp., 324 F.2d 347 (1963) 12, 17, 17n, 21, 26
Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942) 14
Georgia-Pacific Corp. v. U. S. Plywood Corp., 258 F.2d 124 (1958) 21
Hookless Fastener Co. v. G. E. Prentice Mfg. Co., 68 F.2d 848 (1934) 20
I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429 (1926) 21
Interstate Commerce Commission v. Louisville & Nashville Railroad Co., 227 U.S. 88 (1913) 28
Lanzetta v. New Jersey, 306 U.S. 451 (1939) 28
Leggett v. Avery, 101 U.S. 256 (1879) 18
Lincoln Stores v. Nashua Mfg. Co., 157 F.2d 154 (1946) 20
L. S. Donaldson Co. v. LaMaur, Inc., 299 F.2d 412 (1962) 14, 19
Lynch v. United States, 292 U.S. 571 (1934) 27
Missouri Pacific R.R. v. Elmore & Stahl, — U.S. —, decided May 4, 1964 ..... 30n
Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U.S. 425 (1894) 18
Research Products Co. v. Tretolite, 106 F.2d 530 (1939) 14
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) 14
Sears, Roebuck & Co. v. Jones, 308 F.2d 705 (1962) .. 14
Seymour v. Osborne, 78 U.S. 516 (1870) 27
Standard Oil Co. v. Missouri, 224 U.S. 270 (1912) 28
Straussler v. United States, 154 Ct. Cl. 276, 290 F.2d 827 (1961) 14
Strong-Scott Mfg. Co. v. Weller, 112 F.2d 389 (1940) 20
Tschappat v. Hinderliter Tool Co., 98 F.2d 994 (1938) 20, 21
United States v. Cohen Grocery Co., 255 U.S. 81 (1921) 28
Waring Products Corp. v. Landers, Frary & Clark, 263 F.2d 160 (1959) 14
Westinghouse Electric Corp. v. Hanovia Chemical & Mfg. Co., 179 F.2d 293 (1949) 24
Wright v. Georgia, 373 U.S. 284 (1963) 28
Zenith Radio Corp. v. Lehman, 217 F.2d 954 (1955); 121 F.Supp. 69 (1954) 20

RULES AND ORDERS: Page

Fed. R.C.P. No. 18 14
Patent Commissioner's Order No. 3527 of 1940, 520 O.G. 259 ..... 3, 4, 8
Patent Office Rule 41 (1948 reading) 3, 4, 7n, 8, 14, 15, 23, 27, 28
Patent Office Rule 141 (1964 reading) 7n, 14, 15, 27, 28
Patent Office Rule 146 (1964 reading) 7n, 14, 15, 27, 28
Patent Office Supervisory Examiner's Memorandum of July 16, 1943 ..... 15, 16

TEXTS:

69 C.J.S. 720-726 14
McCrady, Patent Office Practice (3rd Ed. 1950) 16, 29
Wolcott's Manual of Patent Office Practice (9th Ed. 1946) 14, 16, 16n

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v.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Ernst Johan Jens Henriksen and W. A. Sheaffer Pen Company, Petitioners above named, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above-entitled case.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals, dated January 20, 1964, is printed in the Appendix hereto, *infra*, p. 1a, and is reported at 327 F. 2d 409. The District Court filed no opinion. The findings of fact and conclusions of law entered by the District Court appear in the Record at pages 405-20.

JURISDICTION

The judgment of the Court of Appeals was initially entered on January 20, 1964 (App. 9a), and became final on February 26, 1964, upon denial (App. 24a) of a timely filed Petition for Rehearing (App. 10a, 20a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Is Patent Office Rule 41 of 1948, providing for a procedural "election of species" in the course of Patent Office applications, constitutional as interpreted by the Court of Appeals below?

2. Where an inventor and the officials of the Patent Office, during the course of an application for a patent, have specifically agreed in writing and of record upon the meaning of certain technical descriptive words of art in the application, has any court the power and competence to declare that the technical descriptive words of art do not have the meaning so agreed upon?

3. Where a Patent Office Examiner, at an early stage of a patent application, requires an applicant to make a provisional, contingent, procedural "election of species" between several different claims under Patent Office Rule 41, which demand the applicant must obey and which is then non-reviewable, may a court

constitutionally interpret such a procedural election of species as a voluntary and unconditional substantive "abandonment" by the applicant of a significant portion of his invention without

(a) considering the entire subsequent history of the application in the Patent Office?

(b) considering whether the contingency, explicitly stated in the election, was satisfied?

(c) considering whether the election was subsequently modified, withdrawn or nullified with the consent of the Examiner?

(d) considering the language and substance of the specification and claims ultimately approved and allowed by the Patent Office?

PATENT OFFICE RULE AND COMMISSIONER'S ORDER INVOLVED

The pertinent provisions of the rules and regulations here involved are Patent Office Rule 41 as it read in 1948 and Patent Commissioner's Order No. 3527 (Official Gazette of the United States Patent Office, Vol. 520, November 12, 1940, page 259) which read as follows:

> "41. Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided,* That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species. In the first action on an application containing a generic claim or claims and claims to more than

one species thereunder the examiner, if he is of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable."

Order No. 3527 "Where an application is filed with claims specific to each of two or more species and a claim or claims generic thereto, the Examiner, in the first action, will give a complete action on the merits of all generic claims, and if no generic claim is found allowable, require election of one species; or if any generic claim is found allowable and the number of species claimed exceeds three, a requirement for election of three species will be made. If, however, the number of species claimed does not exceed three, a full action on the merits of such species claims will also be given where a generic claim is found allowable.

"Where election of species is required, the applicant's response to be complete must include an amendatory action or traverse relating to the rejected generic claims, and an election of species conformably to the Examiner's requirement."

STATEMENT OF THE CASE*

On May 18, 1954, petitioner Henriksen was granted patent No. 2,678,634 (Rec. 299-302) on a novel construction for a ball point pen. Petitioner Sheaffer acquired an exclusive license under this patent including the exclusive right to sublicense others (Rec. 406).

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* All references to the Appendix printed *infra* are indicated by "App". All references to the Printed Record in the Seventh Circuit Court of Appeals are indicated by "Rec".

The invention permitted, for the first time, the simple construction of ball point pens having an ink reservoir of wide diameter and therefore containing a large quantity of ink. Previously the only simple, inexpensive and efficient construction was to use a narrow ink reservoir in which capillary attraction between the ink and the sides of the barrel formed a meniscus which prevented the ink from running out of the barrel when the pen was inverted. Several others had invented complicated and inefficient devices for use with wide diameter reservoirs, none of which proved fully satisfactory in commercial use.

The Henriksen invention is deceptively simple. He provides a "follower" to be placed on top of the ink column in a large diameter reservoir. This follower follows the ink downwardly in the reservoir as the ink flows out when the pen is used, prevents air from contacting the ink or from mixing with the ink, and serves as a complete barrier to the reverse flow of ink out of the reservoir if the pen is inverted. The key to the invention resides in the nature of the follower. As stated in the patent specification, this follower can be a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils) or of wax or of a viscous pulpy mass (Rec. 301). It has the properties of not mixing with the ink and of readily conforming to the side walls of the reservoir (Rec. 301). The patent claims define the follower as a viscous pulpy mass or a flow-resistant pulpy mass (Rec. 302).

The respondent openly copied the Henriksen invention, using as the follower a product known as "Texas Star-O grease" (Rec. 414) which has all of the prop-

erties and characteristics of the follower described and claimed in the Henriksen patent (Rec. 415-16). Petitioners sued for infringement. Jurisdiction of the District Court was founded on 35 U.S.C. 281.

The District Court held the Henriksen patent valid (Rec. 420). The District Court specifically found from trial testimony and documentary evidence that "Texas Star-O grease" was a viscous pulpy mass and a semi-pasty mass of a composition of paraffin (Rec. 416) and that the respondent had infringed the patent (Rec. 420). The Court of Appeals affirmed the validity of the patent (App. 3a). However, the Court of Appeals adjudicated that the respondent had not infringed the patent for the sole reason that Henriksen had unconditionally disclaimed and "abandoned a 'greasy' follower" from the scope of his claims during the administrative proceedings in the Patent Office (App. 3a to 7a). Therefore, the Court of Appeals ruled there was a file wrapper estoppel against the petitioners with respect to a "greasy" follower, including greasy materials which were also viscous pulpy masses (App. 7a).

This decision, if allowed to stand, severely limits the Henriksen patent far beyond the area encompassed by the prior art (Rec. 416-18) or any argument made by Henriksen before the Patent Office to obtain his patent. It advises the industry that the patent can be avoided by the simple device of using a grease for the follower, even though a grease such as Texas Star-O is a viscous pulpy mass or flow-resistant pulpy mass. The Court of Appeals reached this result by the development of a novel and previously unknown extension of the doctrine of file wrapper estoppel, allegedly based upon Patent Office Rule 41 and Patent

Office order 3527, as they existed in the years 1946 to 1948[1]

The proceedings in the Patent Office leading up to the issuance of the Henriksen patent were as follows: The specification of the initial application (Rec. 168-80) filed by Henriksen on October 26, 1946, described the composition of the follower variously as "a body of light metal or a solid or semi-pasty body of a composition of paraffin" or "a viscous or pulpy mass" (Rec. 173). The several original claims presented in the application (Rec. 180-87) recited the follower generically (e.g. claim 9) and defined it variously as light metal (claim 15), resilient material (claim 16),

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[1] Rule 41 finds its counterpart in new Patent Office Rules 141 and 146 which are in effect today. All of the points argued hereafter in this petition are equally applicable to these renumbered rules which read as follows:

> "**141. Different inventions in one application.** Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claim species and all the claims to each species in excess of one are written in dependent form (rule 75) or otherwise include all the limitations of the generic claim."

> "**146. Election of species.** In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case."

solid paraffin (claim 17), wax (claim 18) and pulpy mass (claim 19).

By letter of June 15, 1948 (Rec. 194-95), the Patent Office Examiner rejected all of the generic claims then pending in the application and, *inter alia,* required Henriksen to make an election of species under Patent Office Rule 41 and Commissioner's Order No. 3527. These *required* Henriksen to designate one of the species of followers noted by the Examiner for further consideration by him in the event that a claim which defined the follower generically (e.g. claim 9) was not later considered allowable. The election, however, was to be provisional and contingent, i.e. it was to constitute a final election of species *only* if no generic claim was *ultimately* allowed. It was purely procedural in nature. ***Under the rules Henriksen was compelled to make the election at this time and the demand by the Examiner was non-reviewable.***

In response to the Examiner's non-reviewable demand, Henriksen by amendment filed December 15, 1948, added three new claims, 28, 29 and 30 (Rec. 196-97), in which he variously defined the follower as a viscous mass, a greasy substance and a pulpy mass. He stated (Rec. 198) that claim 28 (viscous) represented the elected species but volunteered the comment that claim 29 (greasy) and claim 30 (pulpy) were directed to species to which elected claim 28 was generic. He then stated voluntarily and not pursuant to any requirement (Rec. 198):

> "Applicant further elects as a single species for the lid [i.e., follower] a lid of pulpy mass *in the event* that no generic claim should be found allowable." [2]

[2] Emphasis added in quoted material unless otherwise noted.

The Examiner had never demanded of Henriksen an election between claims 28, 29 and 30 because they did not become a part of the application until after the demand for election of June 15, 1948.

No final, definitive, unconditional election of anything was required at this time by the Examiner or made by Henriksen. Instead, in a letter dated May 2, 1949 (Rec. 199-200), the Examiner rejected everything. All claims specifying a follower (including the new claims 28, 29 and 30) were rejected on the ground of lack of invention over the prior art.

Henriksen tried again to convince the Examiner. On October 26, 1949, he reduced the number of his claims from thirty to five. In claim 9 he defined the follower generically as "non-solid" (Rec. 182) and in the other specific claims then in the case the follower was described variously as "a pulpy mass" (Rec. 184), "a viscous mass" and "a greasy substance" (Rec. 196-97).

On November 1, 1950 (Rec. 205-206), the Examiner again rejected everything as unpatentable over the prior art, namely, a newly cited Martin patent No. 2,495,013 (Rec. 319-22). In this rejection the Examiner referred in passing to the election of species for the follower. Since he determined to reject everything he made no definitive ruling on the description of the follower.

By amendment filed on April 28, 1951 (Rec. 207-209), Henriksen made one more effort. He withdrew all pending claims and started over with a single new claim 31 which described the follower as "a substantially viscous pulpy mass." This new claim was urged to distinguish over the prior Martin patent on the

grounds that Henriksen's follower was other than ink and that Henriksen's reservoir had a wide diameter. This new claim was also rejected by the Examiner as unpatentable over Martin and this rejection was final (Rec. 210). Henriksen at this juncture took two contemporaneous actions. He filed an appeal to the Board of Appeals from the Examiner's rejection. He also filed a new claim 32 (Rec. 212) which the Examiner rejected (Rec. 225). The relevancy of the Martin patent to the Henriksen claims was the only point at issue before the Board of Appeals (Rec. 216-33).

The Board of Appeals reversed the Examiner (Rec. 233). After this decision the Examiner allowed both claims 31 and 32 of the Henriksen application but *required that the drawings and specification be limited to subject matter embraced within the scope of the claims as allowed* (Rec. 234-35). Henriksen thereupon submitted a substitute description of his invention (Rec. 236-40) in which the composition of the "follower" encompassed by the allowed claims was described as follows (Rec. 237-38, 301):

> "a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils), or of wax, or of a viscous pulpy mass other than said ink . . ."

This description is specifically definitive of respondent's Texas Star-O grease (Rec. 416).

Further, Henriksen in an amendment filed March 4, 1954 (Rec. 248-50) and entered with the specific written approval of the Examiner and the Supervisory Examiner, added an additional claim which defined the follower as a "flow resistant pulpy mass" and specifically

illustrated the compositions of the follower included within the scope of the allowed claims in this language (Rec. 249):

> "One of such followers for example could consist of cup-grease or a mineral oil composition thickened by a mineral soap."

It was conceded by the respondent in the trial court that respondent's Texas Star-O grease is an identical material.[3]

As mentioned above, the Court of Appeals found a "file wrapper estoppel" here by its holding that the provisional, contingent, non-reviewable election of species by Henriksen on December 15, 1948, was in law a final, definitive, unconditional withdrawal and abandonment, for all future time, of a substantial part of his invention.

The Court of Appeals gave no effect to the six-year subsequent history of the application in the Patent Office, or to the subsequent acts of Henriksen, or to the subsequent acts and agreements of the Examiner and the Supervisory Examiner, or to the reversal by the Board of Appeals, or to the agreements with the Patent Office as to the meanings of words of art used in the patent claims, or to the ultimate final action of the Patent Office on Henriksen's invention.

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[3] In respondent's Trial Brief it was stated (page 129): "... the grease component of defendant's accused ball point pens is Texaco Star "O" grease [e.g. Texas Star-O grease]. Such a grease is a composition made up of mineral oil and about 6.6% of a calcium soap. ... The calcium soap is ... a mineral composition." See also respondent's answer to interrogatory No. 24 J III (PX-108).

REASONS FOR GRANTING THE WRIT

A. This case raises questions of national and far-reaching importance in the administration of the patent laws of the United States which have not heretofore been passed upon by this Court.

B. This case involves a principle which, if the decision of the Court of Appeals is allowed to stand, will cast a cloud upon the validity and scope of thousands of presently existing patents.

C. This case involves a new concept of file wrapper estoppel, stated for the first time by the Court of Appeals below, which is inconsistent with all previous decisions of this Court and of all other Courts of Appeal.

D. This case involves a direct conflict between the Seventh and Ninth Circuits, in the only two cases known to counsel for petitioners which have dealt specifically with the meaning and effect of a provisional, contingent, non-reviewable "election of species" in relation to the applicability of the doctrine of file wrapper estoppel. The two decisions are almost contemporaneous. The earlier Ninth Circuit decision (*Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347) is dated October 28, 1963. The diametrically opposed decision by the Court of Appeals in the present case is dated January 20, 1964.

E. This case involves substantial questions of due process of law and the taking of the property of the petitioners without a "day in court."

F. This case involves the fundamental question of the power of the Federal Courts to overrule the spe-

cific written agreement between the Patent Office and an applicant as to the meaning of technical words of art used in the patent application, and the power of the courts to place their own interpretation on these technical words of art, in direct contradiction of the Patent Office agreement.

* * * *

1. The first essential question presented by this petition is whether the Court of Appeals, within the bounds of due process, can limit the effective scope of the Henriksen patent by a ruling that a provisional, contingent and procedural election of species by Henriksen during the very early stages of the application in 1948 was in law a final, definitive, unconditional withdrawal and abandonment by Henriksen of a significant part of his invention and therefore a proper basis for the application of a file wrapper estoppel; and by further ruling that this act in 1948 was to be interpreted in a vacuum, without taking into account the entire history of the subsequent six years of proceedings in the Patent Office, up to the allowance of the patent in 1954.

2. The doctrine of "file wrapper estoppel" is well recognized. If an applicant for a patent, in order to overcome substantive objections on the part of the Examiner, voluntarily and *unconditionally* abandons a part of his claim in order to secure a grant of a patent on the remainder, this voluntary and unconditional abandonment will be binding upon him. The patentee in such a case cannot, after the patent is granted, claim that the language finally allowed in the patent may be broad enough to include, by indirection, that which he unconditionally abandoned in order to get

the patent allowed. There are literally hundreds of cases which have been decided by the District Courts, the Courts of Appeal and this Court in the application of this doctrine. See by way of illustration, *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942) and cases cited at pages 136-37; *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940); *Waring Products Corp.* v. *Landers, Frary & Clark*, 263 F. 2d 160, 164-65 (2 Cir. 1959); *Berry Brothers Corp.* v. *Sigmon*, 317 F. 2d 700, 705 (4 Cir. 1963); *Edward Valves, Inc.* v. *Cameron Iron Works, Inc.*, 286 F. 2d 933, 943 (5 Cir. 1961); *L. S. Donaldson Co.* v. *LaMaur, Inc.*, 299 F. 2d 412, 420 (8 Cir. 1962); *Research Products Co.* v. *Tretolite*, 106 F. 2d 530, 535-36 (9 Cir. 1939); *Sears, Roebuck & Co.* v. *Jones*, 308 F. 2d 705, 708 (10 Cir. 1962); *Straussler* v. *United States*, 154 Ct. Cl. 276, 290 F. 2d 827, 830-31 (1961); cases cited in 69 C.J.S. 720 to 726, § 212, notes 30 to 59.

However, until the decision below, no court has ever predicated a file wrapper estoppel exclusively upon a provisional, contingent, *conditional* election of species made by an applicant during the course of the proceedings in the Patent Office without regard to the full subsequent history of the patent application.

3. An election of species has nothing to do with the substantive merit of an invention. It is purely procedural preliminary matter for the administrative convenience of the Patent Office examiners and is related to the doctrine of "misjoinder" of inventions. See Patent Office Rule 41 (*supra*, pages 3-4); Wolcott's *Manual of Patent Office Practice* (9th Ed. 1946) at pages 105, 107; and present Patent Office Rules 141 and 146 quoted (*supra*, page 7n). It is in some respects parallel to Rule 18, F.R.C.P., 28 U.S.C., re-

lating to the joinder of alternate claims in a civil action.

To use the technical language of the patent law, under old Patent Office Rule 41 and new Patent Office Rules 141 and 146, if an inventor is allowed a generic claim, he may then join with it several species claims which are within the scope of the generic claim; but if no generic claim is allowed, or allowable, the Examiner may interpret the several species claims as separate inventions and may procedurally require the applicant to file separate applications for each. In other words, if no generic claim is allowed, or allowable, the joinder of the several species claims is procedurally, not substantively, improper, and an assertion by the Examiner of procedural misjoinder of claims is appropriate.

Accordingly, the Patent Office practice in 1948 under Rule 41 (the critical time here) permitted an Examiner, at an appropriate stage of the proceeding, to require an applicant to make an election of species where the application for the patent contained claims which, in the opinion of the Examiner, constituted several species and which might conceivably be misjoined. However, such an "election" could never be final nor conclusive because, by definition, there would be *no* misjoinder if a generic claim was ultimately allowed.

Further, since the Examiner's requirement of an election was specifically made contingent and conditional, and since it could have no binding or permanent effect on the inventor until a later stage of the proceedings, the Patent Office practice specifically provided that the Examiner's requirement was to be nonreviewable. Patent Office Supervisory Examiner's

Memorandum of July 16, 1943,[4] *Wolcott's Manual of Patent Office Procedure* (9th Ed. 1946) at page 111.[5] It must be recalled that the election could become final and binding only if, at some later date, there was a "final" action on the application and if no generic claim was ultimately allowed. For this reason, the absence of any right of review at the time when the election was demanded could not raise any constitutional question if the election was initially given no binding or conclusive effect.

However, if at the end of the application process the Patent Office by a "final" action denied any generic claim, then an election previously made and still in effect could validly be considered as definitive, final and unconditional. It would then be reviewable. McCrady, *Patent Office Practice* (3rd Ed. 1950) page 282. To the contrary, if at the end of the application process the Patent Office granted a generic claim, this implied that no valid basis for any election had ever existed and no demand could ever validly be made upon the applicant for a definitive, final, unconditional election between his various species claims. This follows because all his species claims would be properly joined procedurally in a single application, bottomed upon the allowance of the generic claim.

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[4] "The species relationship is a question of fact, unaffected by the presence or absence of a generic claim, and the *Examiner's ruling thereon is, under Notice of October 29, 1940, not subject to review by the Classification Examiner.*" Quoted in Wolcott's *Manual of Patent Office Procedure* (9th Ed. 1946) at page 112.

[5] "Since the above procedure concerns solely election of species under Rule 41, . . . the requirement for election of species is *not subject to review by the Classification Examiner,* nor is any action subsequent thereto dependent upon approval of such requirement."

In the light of this, the applicant's initial election was always stated in contingent and conditional form, e.g. "If no generic claim is ultimately granted to me, and if I am therefore obliged hereafter to choose between species 'A' and species 'B', I will choose species 'A'."

Accordingly, the ultimate effect of a provisional conditional election, made at an early stage, can never be determined without an examination of the entire record of the application, i.e., to determine if, and to what extent, the conditional election had been modified, or had been withdrawn,[6] or had become a nullity, or had become unconditional and binding by reason of the subsequent history of the application. Clearly, the meaning and the effect of a preliminary conditional election can never be determined until the entire Patent Office record is complete and until the ultimate disposition of the application can be studied. (See discussion of *Engelhard Industries, Inc.* v. *Research Instrument Corporation, infra*, pp. 21-23.)

4. The Court of Appeals below adopted an antithetical approach. It refused to consider the full record in the Patent Office. It refused to consider the full history of the application after the 1948 election. It refused to consider whether the contingency expressed in the election had occurred; whether the election had been withdrawn or amended or nullified; or whether a generic claim had in fact ultimately been allowed. It treated the initial contingent election as though it were final and unconditional and substantively binding upon Henriksen for all purposes.

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[6] In its opinion in *Engelhard* (*infra*, p. 22) at 324 F. 2d 350, the Ninth Circuit Court recognized the right of an applicant to withdraw his election of species by his subsequent conduct.

In fact, the history of the patent shows that the 1948 election was in effect wholly withdrawn at a later stage with the consent of the Examiner when new terminology in the form of new claim 31 was adopted to define Henriksen's true invention (Rec. 207-209); the definition of the composition of the follower as stated in that claim was fixed in the record by written agreement between Henriksen and the Patent Office (Rec. 249-50). Everything in the record negates the existence of any definitive and unconditional election in 1948 to abandon a claim to the composition admittedly employed by the respondent. Yet the Court of Appeals ignored the governing facts in the record after 1948 and found, on its own, a file wrapper estoppel by reading the 1948 election in a vacuum as though it were from its inception intended by the applicant to be, and accepted by the Examiner, as final, irrevocable and substantively definitive.

5. The record further shows that the Examiner here never enforced the provisional contingent election. He twice rejected both the generic follower claims and the species follower claims 28, 29 and 30 after the election had been made (Rec. 199-200, 205-206). The Examiner did *not* reject the generic claims *only* and rule favorably on one of the species claims. If the Examiner had done this and if the applicant had acquiesced in this, a file wrapper estoppel would properly have been imposed.

It is the acquiescence which is the key to the question. There can be no estoppel without a definitive, unconditional action and an acquiescence. *Leggett* v. *Avery*, 101 U.S. 256, 259 (1879); *Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152

U.S. 425, 429 (1894); *L. S. Donaldson Co.* v. *LaMaur, Inc.*, 299 F. 2d 412, 420 (8 Cir. 1962).

Yet in this case, no acquiescence can be found. As we have noted, the Examiner never enforced the 1948 election. He threw out the entire invention. He then permitted the applicant in 1951 to withdraw all his then follower claims, both generic and specific, and to file an entirely new follower claim 31 (Rec. 207-209). He then rejected this new single claim as unpatentable over the prior art.

Then, after everything had been rejected, the applicant appealed on the merits and the Board of Appeals reversed. Thereupon the Examiner granted the new claims, exactly as demanded by Henriksen in 1952, four years after the 1948 election (Rec. 234). He went even further. He required Henriksen to limit the disclosure in his patent specification to the exact technical definition of a composition of the follower that was included within the scope of his allowed claims (Rec. 234-35).

Henriksen complied with this requirement and defined the claimed follower *inter alia* as a semi-pasty mass of a composition of paraffin such as a fatty substance or derivative of petroleum and other mineral oils (Rec. 237-38). The Examiner accepted this definition and gave it his approval. This definition encompasses Texas Star-O grease used by the respondent. (Rec. 76).

At a later meeting the Examiner accepted and agreed to an even more specific illustration of the accepted definition of the viscous or flow-resistant pulpy composition of the follower as stated in the claims. One

such illustration, accepted and approved in writing by the Examiner and by the Supervisory Examiner, was "a mineral oil composition thickened by a mineral soap" (Rec. 249). It is conceded that this phrase exactly defines Texas Star-O grease used by the respondent. See footnote 3, page 11, *supra*. Yet this is the very definition which the Court of Appeals said was excluded from the patent grant.

6. In ignoring the record in the Patent Office after 1948, the Court of Appeals departed from the historic theory of the contract nature of the grant of a patent in direct conflict with the other circuits. It did not consider the record as a series of negotiations, freely entered into between the applicant and the Patent Office, to be interpreted in accordance with the general laws of contract negotiations. *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 134 F. 2d 78, 84 (1 Cir. 1943); *Hookless Fastener Co.* v. *G. E. Prentice Mfg. Co.*, 68 F. 2d 848, 851 (2 Cir. 1934); *Strong-Scott Mfg. Co.* v. *Weller*, 112 F. 2d 389, 394 (8 Cir. 1940); *Del Francia* v. *Stanthony Corp.*, 278 F. 2d 745, 747 (9 Cir. 1960); *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938).

The Court of Appeals departed from the historic theory of the importance of the intention of the parties in the interpretation of a patent, in direct conflict with the other circuits. *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 134 F. 2d 78, 83-84 (1 Cir. 1943); *Lincoln Stores* v. *Nashua Mfg. Co.*, 157 F. 2d 154, 158 (1 Cir. 1946); *Zenith Radio Corp.* v. *Lehman*, 217 F. 2d 954 (2 Cir. 1955) affirming opinion in 121 F. Supp. 69, 73 (SD NY 1954); *Strong-Scott Mfg. Co.* v. *Weller*, 112 F. 2d 389, 394 (8 Cir. 1940), *Del Francia* v. *Stanthony Corp.*, 278 F. 2d 745, 747 (9th Cir. 1960); *Di-*

rectoplate Corp. v. *Donaldson Lithographing Co.*, 51 F. 2d 199, 202 (6 Cir. 1931); *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938).

The Court of Appeals ignored the principle laid down by this Court in *I.T.S. Rubber Co.* v. *Essex Rubber Co.*, 272 U.S. 429, 442 (1926) that claims must be given

> "the meaning which was intended by the applicant and understood by the examiner."

It reached the absurd conclusion that a statement in writing by an applicant that his technical words of art specifically included "a mineral oil composition thickened by a mineral soap" (Rec. 249), which statement was officially accepted by the Patent Office, will be held, as a matter of law, to mean that the applicant had definitively and unconditionally abandoned and surrendered all claim to "a mineral oil composition thickened by a mineral soap."

The Court of Appeals ignored the general principle that the applicant for a patent may be his own lexicographer and may invent his own words of art to define the scope of his invention. Here the decision of the Court below is again in conflict with the other circuits. *Georgia-Pacific Corp.* v. *U. S. Plywood Corp.*, 258 F. 2d 124, 136 (2 Cir. 1958);[7] *Electric Storage Battery Co.* v. *Shimadzu*, 123 F. 2d 890, 897 (3 Cir. 1941); *Bianchi* v. *Barili*, 168 F. 2d 793, 799 (9 Cir. 1948).

But most important of all, in refusing to examine or consider the full subsequent history of the patent application in the Patent Office after the 1948 election,

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[7] The court refers to "the meager tools provided by language, tools which admittedly lack exactitude and precision."

the Court of Appeals below is in direct conflict with the principles stated in the very recent decision of the Ninth Circuit in *Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347 (1963), decided October 28, 1963, certiorari denied May 4, 1964. *Engelhard* and the present case are strikingly similar. Both are file wrapper estoppel cases. In each case a provisional election of species was required. In each case, the primary question was the definition of the composition of an essential item in the invention. In each case, *after* the election, the applicant withdraw all his claims and substituted new claims with an amended definition of the composition of the item in question. In *Engelhard* the Examiner did nothing affirmative; he merely failed to object to the new definition. In the present case, the Examiner affirmatively approved the new definition in writing and emphasized this by requesting and then approving in writing specific illustrations of the meaning of the definition.

In *Engelhard* the District Court had found a file wrapper estoppel (324 F. 2d 349). The Court of Appeals found otherwise, properly interpreting the effect of the conditional election of species by an analysis of the subsequent withdrawal of claims, the substitution of new wording for the critical definition and the meaning of the new wording by an examination of the entire subsequent Patent Office record and the subsequent actions of the Examiner. The present case is the exact opposite. Here the District Court did not find a file wrapper estoppel. The Court of Appeals reversed, treating the conditional election of species as absolute and refusing to analyze the subsequent withdrawal of claims, the substitution of new wording for the definition of the invention and the meaning of

the new wording by an examination of the entire subsequent Patent Office record and the subsequent actions of the Examiner. The conflict could not be more irreconcilable.

7. The Court of Appeals decided this case in direct violation of Patent Office Rule 41, the rule under which Henriksen made his election. That rule provides that the applicant need make only a conditional election, i.e.,

> "to elect that species of his invention to which his claims shall be restricted *if no generic claim is finally held allowable.*"

Yet the Court of Appeals held here that the claims will be restricted under the election without regard to whether a generic claim was ultimately allowed and without regard to whether the election was later amended or withdrawn with the consent of the Patent Office. Neither this Court nor any other Court of Appeals nor Neither this Court nor any other Court of Appeals nor District Court has ever laid down such a rule before. This Court has never before passed upon this important question.

8. The case raises another basic question, namely: Who is to determine what the Patent Office intended by the use of technical words of art in the grant of a patent and what are the limits of the powers of the courts to interpret the meaning of those technical words of art? Obviously, if the record in the Patent Office is ambiguous, and if the meaning of the technical words of art is not clear, that is, if there is no clear "legislative history," then the courts have no choice except to assume the burden of resolving the ambiguities in the Patent Office record.

But if there is no ambiguity in the Patent Office record, and if the very question of the meaning of the technical words of art, as presented to the Court, has been presented *in ipsissimis verbis* to the Patent Office and answered by it definitively and unconditionally, then what power has any court to overrule the expressed agreement between the applicant and the Patent Office as to their meaning?

Counsel for the petitioners have found no direct authority on the point in any decided case. They have found two *dicta,* in the Second and Third Circuits, which are illustrative and helpful. The first *dictum* is in *Westinghouse Electric Corp.* v. *Hanovia Chemical & Mfg. Co.,* 179 F. 2d 293, 296-97 (3 Cir. 1949), in which the court said:

> "The claims of a patent must always be explained by and read in connection with the specification and *in the light of definitions* and admissions made by the applicant in the proceedings in the Patent Office."

This record perfectly illustrates the principle of the *Westinghouse* case. The applicant and the Patent Office officials agreed in 1953 that a viscous pulpy mass included a mineral oil (greasy) composition (Rec. 238). They further agreed in writing in March, 1954 (Rec. 249), that the definition of the composition of the follower as recited in the patent claims should include, *inter alia,* "a mineral oil composition thickened by a mineral soap" (i.e., a grease). Has the Court of Appeals the power to decide that the definition finally approved by the Patent Office does *not* include this material? And if so, where does that power arise?

In the other *dictum* Judge Learned Hand considered this matter and expressed it even more dramatic-

ally in his opinion in *Dwight & Lloyd Sintering Co.* v. *Greenawalt*, 27 F. 2d 823, 832 (2 Cir. 1928). In his discussion of the file wrapper history to determine the meaning of the terms used, he said:

> "After the claims have received an interpretation on which alone they secured any allowance at all, *we conceive ourselves bound by the meaning so put upon them. Anything else makes an absurdity of the proceeding itself.*" (emphasis supplied)

Can file wrapper estoppel extend to deny the Examiner the right to decide what he is granting? It is the Examiner, not the court, who determines the scope of the grant. If the Examiner advised the applicant that he is granting him a patent for a certain designated invention, with a clearly defined definition of technical terms, can the court decide that the Examiner unconditionally required the applicant to abandon the very invention and the very definition which the Examiner specifically told the applicant he was granting him? As Judge Hand said, such a doctrine truly leads to an absurdity.

9. The effect of the decision below goes far beyond the confines of this one patent and this one infringement.

There are thousands of patents outstanding today in which at some stage the inventor had been asked to make a contingent preliminary election of species. Before the decision below, no court has ever suggested that every such election, no matter how conditionally it is stated, is in fact unconditional and acts as a substantive restriction on the invention *without regard to what happened thereafter in the Patent Office.* It has always been assumed that the effect of such a con-

ditional election depends entirely upon the future history of the patent application, upon the future actions of the inventor, the future actions of the Examiner and the ultimate fate of the application itself. (See *Engelhard, supra,* p. 22, which sets forth this latter rule.)

This conflict is so important to the patent laws that review by this Court is now appropriate. If the decision below remains unreviewed, it will be the leading case for the Seventh Circuit, the center of the huge industrial Middle-Western complex and a powerful factor in patent litigation. Every existing patent, in the course of which an election of species has been made, will now become vulnerable in that Circuit to substantive annulment by imposing the rule that a conditional election is in fact unconditional and that, *irrespective of the future history of the application,* the inventor will be held to have abandoned unconditionally a significant part of his invention. If this decision is not reviewed by this Court, and if the conflict with *Engelhard* remains unresolved, other Courts of Appeal will have the choice to adopt either of the diametrically opposed doctrines of the decision below and of *Engelhard,* with chaotic results to the meaning and scope of thousands of United States patents.

Further, this decision strikes at the heart of the patent system. It takes away from the Examiner and the Patent Office officials the control of patent applications and the power to agree, during the administrative process, upon the meaning of the technical words of art in a patent. It permits the court to decide that where the Patent Office specifically says that the technical language of the patent is granted to include items of the color "red," the court may rule that

the patent never was intended to cover "red" items and that anyone may practice "red" without infringement.

The decision also raises fundamental constitutional questions.

10. The grant of a patent is the creation of a valuable property right through action of the Patent Office under authority of the Congress and founded upon Article I, Section 8, Clause 8 of the Constitution. Like all other property rights, including all contracts of the United States, it is protected by the Fifth Amendment from confiscation without due process of law. *Seymour* v. *Osborne*, 78 U.S. 516, 533 (1870); *Cammeyer* v. *Newton*, 94 U.S. 225, 226 (1876); *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 425 (1908); *Lynch* v. *United States*, 292 U.S. 571, 579 (1934).

If Patent Office Rule 41, upon which the Court of Appeals relied (App. 5a, 6a), (its renumbered counterparts, new Rules 141 and 146 being in the same situation) is interpreted as the Court of Appeals has interpreted it, it is clearly unconstitutional on two independent grounds.

First, the rule provides for a contingent, provisional, conditional election of species, to be effective *only if* "no generic claim is finally held allowable." No notice is given in the rule that, under any circumstances, it can be a final, unconditional, binding abandonment of invention the moment it is made and without regard to the subsequent history of the generic claims and of the application in the Patent Office. If finality is ascribed *ab initio* to the election, without warning or

notice that this result can follow, then the rule is fatally defective insofar as it may result in the confiscation of property rights without notice.

Second, the Rule is unconstitutional because no provision is made for any contemporaneous hearing at which the applicant may be heard on the issue of the validity of the Examiner's demand for an election which will result in a mandatory abandonment *ab initio* by the inventor of part of his invention. *Standard Oil Co.* v. *Missouri,* 224 U.S. 270, 281 (1912); *Interstate Commerce Commission* v. *Louisville and Nashville Railroad Co.,* 227 U.S. 88, 91 (1913).

Further, Rule 41 (and its renumbered counterparts new Rules 141 and 146) now will have become a trap, even for the wary. The situation is constitutionally similar to that of the vague and ambiguous criminal statute which gives no adequate notice of the nature of the alleged offense. Such statutes are unconstitutional. *United States* v. *Cohen Grocery Co.,* 255 U.S. 81, 89 (1921); *Lanzetta* v. *New Jersey,* 306 U.S. 451, 458 (1939); *Champlin Refining Co.* v. *Corporation Commission of Oklahoma,* 286 U.S. 210, 243 (1932); *Connally* v. *General Construction Company,* 269 U.S. 385, 394-95 (1926); *Wright* v. *Georgia,* 373 U.S. 284, 293 (1963).

Here Rule 41 unambiguously tells an applicant that if he obeys the order of the Examiner and makes an election of species, his election is only contingent and conditional. Yet the Court of Appeals has convicted him of having thereby made a noncontingent and unconditional abandonment of the substance of part of his invention, *ab initio,* without regard to what hap-

pened later on in the Patent Office and without regard to the terms and provisions of the patent ultimately granted to him. He is clearly entitled to invoke the constitutional principle that the Court of Appeals has taken his property from him without notice and without any opportunity for a "day in court."

The applicant has no right of appeal or review of an Examiner's demand for a procedural election of species until after "final" action on the application, McCrady, *Patent Office Practice* (3rd Ed. 1950) page 282. But suppose, as in the present case, the initial election is withdrawn or so modified, with the consent of the Examiner, that the applicant ultimately gets everything in his patent that he wishes. From what does he then appeal?

Clearly a right of appeal is required if the initial election remains unmodified and ultimately becomes final and binding on the applicant. Then, if he feels the Examiner has erred in requiring this limitation on his patent, he may have a review. But equally clearly, the applicant has nothing from which to appeal if the tentative conditional election disappears during the subsequent course of the proceedings in the Patent Office and the applicant ends up with everything that he desires.

Under the decision below, the applicant is hopelessly trapped. He has made a conditional election which is initially non-reviewable. Then the election is later withdrawn, or amended, or otherwise disappears from the record with the consent of the Patent Office officials. The applicant then receives the full grant that he seeks. Nothing remains from which he may

appeal. And now the courts declare that his ultimate patent grant is limited by that initial non-reviewable conditional election which later disappeared from the proceedings.

Finally, this case raises the question of the power of the Federal Courts to destroy patents by arrogating to themselves the power to read technical words of art as used in a patent grant as they please, without considering the agreements and specifically expressed intentions of the applicant and the Patent Office as to the meaning to be ascribed to those words in the patent grant (see Judge Hand in *Dwight & Lloyd Sintering, supra,* p. 25).

CONCLUSION

Because of the urgent necessity of resolving the conflict between the decision below and *Engelhard*' (decided in two different circuits within less than ninety days of one another and both within the last six months'), because of the unconstitutional interpretation of the Patent Office rule by the Court below, because of the improper arrogation of power by the Court of Appeals to annul the written agreements of the Patent Office authorities, and because of the nationwide impact of the conflicting decisions on the entire

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' Missouri Pacific R.R. v. Elmore & Stahl, decided May 4, 1964.

field of patents, it is respectfully requested that a writ of certiorari be granted.

Respectfully submitted,

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IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 14070 SEPTEMBER TERM, 1963 JANUARY SESSION, 1964

ERNST JOHAN JENS HENRIKSEN and W. A. SHEAFFER PEN COMPANY, *Plaintiffs-Appellees,*

v.

CORY CORPORATION, *Defendant-Appellant.*

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

January 20, 1964

Before HASTINGS, *Chief Judge*, DUFFY and CASTLE, *Circuit Judges.*

DUFFY, *Circuit Judge.* This is a suit alleging infringement of Henriksen Patent No. 2,678,634 issued on May 18, 1954, and entitled "Writing Instrument."

Co-plaintiff, W. A. Sheaffer Pen Company, acquired from Henriksen an exclusive right to make, use and sell in the United States, writing instruments embraced within the scope of the claims of the Henriksen patent.

The patent in suit relates to the construction of a ball-point pen. The specification describes the pen as including an ink reservoir and a writing ball mounted in a nib in the forward end of the reservoir. Two vents are provided in the rear end of the reservoir in order to prevent a vacuum from forming in the air space above the ink as the ink is withdrawn from the reservoir during the writing operation.

The defendant asserts the invalidity of the patent in suit, claims non-infringement and urges as a further defense, the alleged misuse of Henriksen Patent No. 2,678,634.

The principal issue in the suit pertains to what is designated as the "follower." In the writing instrument described in the patent in suit, during writing, ink is fed by gravity to the writing ball. The diameter of the reservoir is such that if the pen is inverted, the ink would normally flow rearwardly through the vent and out of the reservoir. To prevent such a flow of the ink, a follower is inserted in the reservoir and is positioned on the upper surface of the ink. Another purpose of the follower is to prevent air mixing into the ink which might form bubbles and thus interfere with the writing functions of the pen.

The follower is frequently referred to as "follower mass." This follower must be other than ink and is of such a character that it does not mix with ink.

The pens manufactured and sold by defendant all have an ink reservoir, a writing ball and a follower. However, defendant claims that its follower has a composition different from the one claimed in the patent in suit, and hence there is no infringement.

Henriksen, the patentee, does not claim to be the originator of ballpoint pens or of such pens with a follower. All of the claims of the Henriksen patent are directed to a follower which is "pulpy."

On July 1, 1955, plaintiff Henriksen granted to co-plaintiff, W. A. Sheaffer Pen Company, a license which was designated "exclusive." Under the terms of the license agreement, Sheaffer was required to grant licenses to seven other pen manufacturers who were named in the license. One additional licensee was provided for, who was to be selected by mutual agreement of Sheaffer and Henriksen. The license to Sheaffer specified the precise nature and form of the sublicenses which Sheaffer was required to

grant. Included was the provision that such sublicensees must accept a license not only under the patent in suit, but under various foreign patents, and to pay minimum royalties on both United States and foreign sales.

The District Court held the patent in suit valid, and that it was infringed by defendant's writing instrument. Also, the District Court failed to find that plaintiffs had misused the patent in suit.

Although defendant's claim of invalidity was strongly urged in the District Court, that issue has been virtually abandoned on this appeal. In any event, we are of the view that the finding and conclusion of the District Court that the patent is valid, is justified by the record before us.

On the question of infringement, it is undisputed that defendant's follower is composed of Texas Star "O" grease.[1] This grease is a common lubricating grease and, therefore, is a "greasy substance." Defendant strongly urges that Henriksen clearly disclaimed followers which were of a greasy substance, and that he is now attempting to assert that the "pulpy" claims in the patent in suit cover followers made up from a greasy substance.

Defendant relies on the well-established principle that a patentee cannot regain in court, claims covering devices which he specifically abandoned in the Patent Office. *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 7 Cir., 301 F. 2d 882, 886.

As originally filed, Henriksen's application described the followers in this language:

> "6 is a lid or follower slidably mounted within the ink reservoir 3 adjacent the surface of the ink or paste 7 contained therein. This lid or follower which may be a cylindrical body of small weight f. inst. a

[1] In the transcript and in appellees' brief, the grease is referred to as Texas Star "O" grease. In appellant's brief it is called Texaco Star "O" grease.

body of light metal or a solid or semi-pasty body of a composition of paraffin or may consist of a substance having approximately the same viscosity as the ink but of such a nature that it is unable to mix therewith, is adapted to prevent the air admitted through the air intake 5 to contact the surface of the ink 7 and also to prevent the ink from flowing from the reservoir into the interior of the barrel.

"Alternatively the lid or body 6 may consist of a layer of viscous or pulpy mass of substantially the same viscosity as the ink and having a color which is distinctly different from the color thereof, thereby providing means for advertising the user when the ink in the reservoir is approaching exhaustion which will become apparent from the change of color on the writing paper when the pulpy mass above the ink column is extracted through the ink feeding channel to the writing ball."

The original specification thus appears to divide followers into two groups. In the first, the follower is a body of light metal or a solid or semi-pasty body of a composition of paraffin; and, in the second, the follower may be a viscous or pulpy mass similar in viscosity to the ink, but of a different color so as to advise the user when the ink in the reservoir is near exhaustion.

Some two years after the filing of the original application, Henriksen added the following three claims:

"28. In an ink reservoir for ball point fountain pens including an ink column within said reservoir; a viscous mass adjacent the surface of said ink column and providing an air tight follower above said ink column within said reservoir, said viscous mass being of such a nature that it is unable to mix with said ink.

"29. In an ink reservoir for ball point fountain pens including an ink column within said reservoir; *a layer of a greasy substance* above the surface of said ink column, said greasy substance forming an air tight follower capable of sliding within said reservoir following the surface of said ink column, the nature of

said greasy substance being such that it is unable to mix with said ink.

"30. In an ink reservoir for ball point fountain pens including a column of pulpy ink within said reservoir; *a layer of a pulpy mass* on the surface of said ink column, said pulpy mass having substantially the same viscosity as the pulpy ink and forming a slidable follower within said reservoir, said pulpy mass and said pulpy ink being immiscible with each other." (Emphasis supplied).

In arguing these new claims, Henriksen took the position that Claim 29 is limited to followers which are "greasy"; that Claim 30 is a claim to a different species in one of which the follower is "pulpy" while Claim 28 is the generic claim covering both species, stating: "Claims 29 and 30 are directed to the species of a greasy substance and pulpy mass, respectively, as species to which Claim 28 is generic."

In the same amendment, after emphasizing that "pulpy" is something different from "greasy", applicant stated: "Applicant further elects as a single species for the lid a lid of pulpy mass in the event that no generic claim should be found allowable." This election of species was made under Rule 41[2] of the Patent Office.

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[2] "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided*, That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species. In the first action on an application containing a generic claim or claims and claims to more than one species thereunder the examiner, if he is of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable."

Under Rule 41 of the Patent Office, where generic claims are rejected and claims to independent species remain, the applicant must elect a single species "to which his claims shall be restricted." Henriksen elected the "pulpy" species.

Claims 28, 29 and 30 were rejected by the Patent Office on the prior art, were reargued by the applicant, again rejected by the Patent Office, and were finally cancelled by Henriksen who substituted therefor Claim 31 (the latter became Claim 1 of the Patent), which claim called for the follower to be "pulpy."

We agree with plaintiffs that, generally speaking, one device is an infringement of the other if it performs substantially the same function in substantially the same way to obtain the same result. In other words, if two devices do the same work in substantially the same way and accomplish the same result, they are the same even though they may differ in name, form and shape.

In the case at bar, we would hold there was infringement of the patent in suit by defendant's pen were it not for the file wrapper estoppel and Henriksen's election under Rule 41 of the Patent Office whereby Henriksen clearly abandoned a "greasy" follower and limited his patent to the "elected species" where the follower is "pulpy."

Pertinent is the language in *Hubble* v. *United States*, 179 U.S. 77 where the Court stated at pages 83-84: ". . . [L]imitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public and looked upon as in the nature of disclaimers."

Also pertinent on this point is the statement of this Court in *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 301 F. 2d 882, 886: "Had Claim 13 been allowed, it might well have covered the one part accused North Star blade, but since it was rejected and

cancelled by the applicant, the assignee of applicant is estopped to broaden by interpretation, the claims of its patent to embrace that which was given up in the Patent Office."

It is urged that we are bound by the District Court's findings. It is true there were three findings below which state or imply that grease may be considered as a pulpy mass. All of the findings in the instant case were entered in the precise form submitted by plaintiffs' counsel. The District Court did not file an opinion or otherwise discuss the applicable law.

The situation here is similar to that in a case recently considered by this Court. In *Taylor-Reed Corporation* v. *Mennen Food Products, Inc.*, 7 Cir., 324 F. 2d 108, where the judgment below was reversed on the ground of file wrapper estoppel. We said at page 111:

> "The district court made a number of findings of fact contrary to the conclusion we have reached. Since we are able to resolve this question on the basis of documentary evidence, the findings of the district court on this issue are deprived of the degree of finality which would otherwise attach under Rule 52(a) [citing authorities] We hold, therefore, the such contrary findings on this proposition must be set aside."

Construing the patent in suit in view of its file wrapper history, we hold the District Court was in error in finding and concluding that defendant's pen infringed the claims of the patent in suit. We hold more specifically, defendant's accused writing instruments known as Autopoint 3-X, Autopoint Cargo and Autopoint Jetliner ball point pens did not infringe the patent in suit.

The third point raised by defendant is the alleged misuse of the patent in suit. Defendant relies upon the license agreements *per se*. The claim of misuse is confined to two provisions of the license agreement, 1) an alleged "package" licensing program which is said to require the licensee

to take licenses under foreign patents as a condition to receiving a grant of a license under the patent in suit, and 2) an alleged "veto" power given to Sheaffer over the grant of an additional license to one unnamed potential licensee.

It was not until June 21, 1961 that defendant filed an amended answer which alleged plaintiffs had misused the Henriksen patent. In the findings of fact, the District Court found there was no evidence that plaintiffs have collaborated in an attempt to control ball point pens or other items not properly included within the scope of the Henriksen patent. Further, that there is no evidence of any conspiracy to restrain trade in unpatented items. Also, that there is no evidence that Sheaffer grants sublicenses only to larger manufacturers of ball point pens. As a conclusion of law, the Court determined that plaintiffs had not made any agreements or engaged in any activities which constitute a misuse of the patent in suit.

Plaintiffs point out that the two items now relied on by defendant to show misuse of the patent in suit were asserted for the first time in a "Supplement to defendant's trial brief" served only four days prior to the commencement of the trial. This was four years after defendant's original answer and counterclaim were filed. There never has been a pleading of the specific items of misuse now asserted. There was no explanation by defendant for this long delay in raising these new matters. We hold the Court's rulings on evidence relating to these impleaded items were not error and we overrule the defense of misuse.

Due to our holding of non-infringement, the judgment of the District Court is

REVERSED.

A true Copy:
Teste:

Clerk of the United States Court of Appeals for the Seventh Circuit.

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago 10, Illinois

Monday, January 20, 1964

Before
HON. JOHN S. HASTINGS, *Chief Judge*
HON. F. RYAN DUFFY, *Circuit Judge*
HON. LATHAM CASTLE, *Circuit Judge*

No. 14070

ERNST JOHAN JENS HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

vs.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, REVERSED, with costs, in accordance with the opinion of this Court filed this day.

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 14070

ERNST JOHAN JENS HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

HONORABLE RICHARD B. AUSTIN, *Trial Judge.*

Petition for Rehearing.

To the Honorable Judges of the United States Court of Appeals for the Seventh Circuit:

Ernst Johan Jens Henriksen and W. A. Sheaffer Pen Company, plaintiffs-appellees in the above entitled appeal, respectfully present this petition for rehearing in said appeal on the ground that this Court's opinion dated January 20, 1964, shows a misconception of certain facts in this case, and justice requires that the decision of the District Court on the issue of infringement should be affirmed.

SUMMARY OF REASONS OF PETITION.

1. This Court's opinion fails to give effect to the fact that *witness testimony* given during the course of a four and one half day trial and other evidence of record abundantly support the finding of the District Court that Texas

Star-O grease used by defendant is a viscous pulpy mass and, under Rule 52 (a) F.R.C.P.; 28 U. S. C., such finding should not have been set aside.

2. This Court's opinion is contrary to established precedent that the withdrawal of one claim during prosecution of a patent application does not constitute an abandonment of subject matter directly encompassed within the literal language of another allowed claim and that file wrapper estoppel does not apply as to such subject matter.

3. This Court's opinion depreciates findings of fact made by the District Court for the reason that they were drafted by Plaintiffs' counsel, contrary to established precedent as exemplified by Judge Sparks' decision in *Taylor Instrument Companies* v. *Fee & Stemwedel, Inc.*, 129 F. 2d 156, 160-161 (7 Cir. 1942) and by Judge Major's decision in *Hazeltine Research, Inc.* v. *Admiral Corp.*, 183 F. 2d 953, 954 (7 Cir. 1950).

It is not intended by this petition to reargue the infringement aspects of this case inasmuch as this argument was presented on pages 27-49 of plaintiffs' main brief. However, it is an intention of this petition respectfully to direct this Court's attention to certain witness testimony presented in open court which provides ample support for the findings of the District Court relative to the scope and meaning of the term "viscous pulpy."

Reasons of Petition.

The sole basis for reversal of the District Court was noninfringement and this Court's opinion contains the statement (page 5):

> "... we would hold that there was infringement of the patent in suit by defendant's pen *were it not for the file wrapper estoppel and Henriksen's election under Rule 41** of the Patent Office. . . ."

*Emphasis added in all quoted matter unless otherwise indicated.

Plaintiffs do not dispute that during prosecution of the Henriksen patent application there was a technical election required and made between claim 29 reciting a "greasy substance" and claim 30 reciting a "pulpy mass" under Patent Office Rule 41. However, an election *per se* does not give rise to an estoppel. The estoppel arises when a claim is amended or cancelled and it extends only to subject matter embraced by the original claim which is not specifically included within the literal scope of the amended or a newly added claim. *Hunt* v. *Armour & Co.*, 185 F. 2d 722, 727 (7 Cir. 1950). The new claim 31 (which eventually became claim 1 of the patent) reads literally on defendant's accused Autopoint pens *and the estoppel extends only to greasy substances which are not viscous and pulpy.*

Witness Testimony Supports the District Court's Finding That Texas Star-O Grease Is a Viscous Pulpy Mass.

The District Court found (D. App. 416):

"58. Texas Star-O grease is a viscous pulpy material."

This finding and related findings are based upon testimony given by Dr. Carl S. Miner, Jr., at the trial and are not based solely upon documentary evidence. Dr. Miner, fully qualified as one skilled in the art (P. App. 1-2; D. App. 18-22), testified extensively at the trial concerning the compositions and properties of ball point pen inks, follower materials and greases. (P. App. 4-44, 128-39; D. App. 21-29).

Dr. Miner's testimony included the following (P. App. 10):

"Q. *Can you give exampies of viscous pulpy masses* that would serve the purpose of holding the ink in place and readily following it through the reservoir?

"A. Yes. Examples would be petrolatum, a material commonly known as vaseline—that is the trade name—*lubricating greases*, certain jelly-like material, silica jelly, for example, materials having the con-

sistency of ointments, material such as can be made by thickening a non-oily liquid such as glycerin with clays or with starch.

"Q. *Which of these materials are semi-pasty masses,* would you say, that you have just mentioned?

"A. I would say *all of these* materials are semi-pasty masses.

"Q. *Which of these materials are semi-pasty masses of the composition of paraffin?*

"A. Of those that I mentioned, the materials that will comply with that description are the petrolatum.

"The Court: That is the Vaseline?

"The Witness: Yes.

"By the Witness:

"A. (Continuing) *And the lubricating greases.*"

It is admitted by defendant that Texas Star-O is an ordinary lubricating grease (D. Br. 2, 16) and that this grease has been known for perhaps twenty years (P. App. 245-46).

Defendant has urged, and this Court's opinion has tacitly accepted the argument, that a "pulpy" material cannot be "greasy" or that a "pulpy" material *must* be something other than "greasy." This argument is not supported by the record of this case and was not accepted by the District Court. Initially defendant urged that a grease cannot be pulpy for the reason that a characteristic of a "pulpy" material is that it contains fibers or is fibrous in nature. However, this position has been abandoned because those skilled in the art are aware that lubricating greases such as Texas Star-O have a fibrous structure. This was admitted by one of defendant's witnesses (D. App. 385) and is substantiated by Dr. Miner's trial testimony (D. App. 29) and a standard textbook reference on greases by Klemgard (P. App. 223-27). The viscous pulpy nature of Texas Star-O grease is apparent from an examination of physical exhibit PX-114 which was demonstrated to this Court at the argument on appeal.

Dictionary definitions of "pulpy" and "pulp" are not restrictive to substances that are non-greasy but are broad enough to include greasy materials (P. App. 39-40, 229). Dr. Miner pointed out (D. App. 27-28) that even in the technical grease art the word "pulp" has been used to define a substance comprising a mixture of soap and oil, *i.e.*, an aluminum soap containing a small amount of mineral oil (P. App. 228).*

The evidence referred to above was presented by testimony in open court and amply supports the specific finding by the District Court that Texas Star-O grease is a viscous pulpy mass. *There was no conflicting witness testimony given at the trial relative to this matter.* It is respectfully submitted that under Rule 52 (a) this Finding of Fact No. 58, and related findings, should not have been set aside. This Court's opinion has erroneously accepted defendant's unsupported arguments concerning "pulpy" vis-a-vis "greasy" which are contrary to the witness testimony and other evidence on which the District Court based its findings.

There Is No File Wrapper Estoppel by the Cancellation of One Claim If the Retained Claim Reads Literally on the Accused Device.

Inasmuch as the term "viscous pulpy mass" used in the Henriksen patent claims literally embraces Texas Star-O grease, as found by the District Court, there can be no file wrapper estoppel resulting solely from the withdrawal of a claim reciting a "greasy substance" and replacing that claim with another claim which defines the follower material as a "viscous pulpy mass."

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*Texas Star-O grease is a mixture of calcium soap and a mineral oil (P. App. 245).

The case at bar is almost "on all fours" with *Ceramic Process Co.* v. *General Porcelain Enameling & Manufacturing Co.*, 129 F. 2d 803 (7 Cir. 1942), in which the patent in suit involved a method of applying designs to a vitreous surface utilizing a particular composition which was forced through a fine mesh onto the surface to be decorated. Claims were first submitted to the Patent Office which defined the composition as *paint-like*. These claims were later amended by reissue to define the composition as *pasty* in order more particularly to express a degree of viscosity. In litigation the defendant urged file wrapper estoppel on the ground that the accused method used a *paint-like* composition and, the term "paint-like" having been withdrawn from the original claims, the patent owner was estopped to assert that the claims properly embraced a process using the *paint-like* composition. This argument was rejected by the Court and Judge Sparks' opinion pointed out that even though defendant's composition was *paint-like*, it was also *pasty* and the process was within the ambit of the claims as amended.

In the case at bar, Henriksen cancelled claims 28, 29 and 30 which variously defined the follower as "viscous", "greasy" and "pulpy." New claim 31 was substituted for all of them and contained the term "viscous pulpy" which expressed a degree of consistency of the follower material which was not expressed in the earlier claims. Thus "viscous pulpy" was used to distinguish the claimed follower from the slug of liquid ink shown as a follower material in the capillary reservoir of the then newly cited Martin patent. It includes lubricating greases and other substances that are viscous and pulpy (P. App. 10). Similarly to the *Ceramics* case, Henriksen's withdrawn claim covered defendant's ball point pens but the new claim also literally reads on the accused devices and infringement is established.

The law is well settled that the doctrine of file wrapper estoppel is not applicable in cases where both withdrawn

and accepted claims read directly on the accused structure. *Smith* v. *Snow*, 294 U. S. 1, 15-16 (1935) and *Hunt* v. *Armour & Co.*, 185 F. 2d 722, 727 (7 Cir. 1950). In *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 301 F. 2d 882 (7 Cir. 1962) and *Hubbell* v. *United States*, 179 U. S. 77 (1900) cited in this Court's opinion in the case at bar, the accused devices or methods lacked an element specified in the patent claims which was not present in the original cancelled claims. Each and every element specified in the Henriksen patent claims is found in the Autopoint ball point pens.

This Court's opinion quotes from the original Henriksen patent application and concludes (page 4):

> "The original specification thus appears to divide followers into two groups."

The implication is that Henriksen by election and amendment limited himself to claim only one of these groups (which one is not specified). However, *the distinction in the Henriksen application between the two groups is* **not** *based upon any difference in chemical composition which would separate greasy from nongreasy or pulpy from nonpulpy.* The given definition *for each group* obviously includes lubricating greases if it otherwise satisfies the specifications given. The District Court specifically found (F. F. 57, D. App. 416), and Dr. Miner and defendant's witness Mr. Nelson agreed (P. App. 10, 113-14), that Texas Star-O grease is a semi-pasty body of a composition of paraffin which defines a substance in the first group. The District Court also found that Texas Star-O grease is a viscous pulpy material (F. F. 58, D. App. 416) which is a characteristic of a follower included within the second group. This latter finding is supported by the evidence including Dr. Miner's trial testimony as previously noted (P. App. 10).

The Findings of the District Court Are Based on Witness Testimony and Should Not Be Depreciated for the Reason That They Were Drafted by Plaintiffs' Counsel.

In this Court's opinion the findings of the District Court relative to the viscous pulpy nature of Texas Star-O grease were set aside. In so doing these findings were depreciated for the reason that they "were entered in the precise form submitted by plaintiffs' counsel."

It has long been the practice in patent cases for the trial court to require counsel for the parties to submit proposed findings of fact and conclusions of law after the trial has been completed but before a decision is announced. This practice is specifically authorized under Rule 13 of the Civil Rules of the United States District Court for the Northern District of Illinois which reads as follows:

> "In any civil action, where findings of fact and conclusions of law are required, *the court may require from either or both parties, before or after the announcement of its decision, proposed findings of fact and conclusions of law,* for the assistance of the court, but, unless adopted by the court, such proposed findings of fact and conclusions of law shall not form any part of the record of the action."

In this case the proposed findings were carefully prepared and each is supported by the record. If this Court's opinion is allowed to stand, plaintiffs will be penalized because counsel took pains to draft findings supported by the record which could be and were adopted by the District Court "in the precise form submitted."

The attitude expressed in this Court's opinion in the case at bar is diametrically opposed to the prior decisions of this Court in *Taylor Instrument Companies* v. *Fee & Stemwedel, Inc.*, 129 F. 2d 156 (7 Cir. 1942) and *Hazeltine Research, Inc.* v. *Admiral Corp.*, 183 F. 2d 953, 954

(7 Cir. 1950). In the *Taylor Instrument* case Judge Sparks said (pp. 160-61):

> "Appellant more than once refers to the fact that the court adopted the findings tendered by appellee, thereby intimating, if not directly saying, that the court should have written its own findings. This is an old argument which is often resorted to by unsuccessful litigants. Each party, if he so desires, may present findings setting forth his theories and the evidence which he thinks support those theories. It then becomes the duty of the court to select the findings which it thinks are correct. If all or any part thereof are wrong they of course should be rejected. They may be restated in other language if the court so desires, or they may be adopted as requested if the court so desires. *If the court adopts them they become the court's findings regardless of who wrote them, and after that the only issue is their correctness, and we do not concern ourselves with their original authorship.*"

If it was the intention of this Court in the present case and in the more recent case, *Johnson & Johnson* v. *The Kendall Company*, Appeal No. 14227, decided January 22, 1964, to overrule the prior decisions in this circuit as established in the *Taylor Instrument* and *Hazeltine* cases, then it is respectfully suggested that the Court should have expressly done so in order to relieve uncertainty in future litigation.

Taylor-Reed Corporation v. *Mennen Food Products, Inc.*, 324 F. 2d 108 (7 Cir. 1963) was referred to in support of the propriety of setting aside findings of fact which the appellate court is able to resolve *on the basis of documentary evidence*. This Court then assumed that a proper basis for reversal was contained solely within the file wrapper of the Henriksen patent. This is a mistaken assumption. *The issue is whether the terminology "viscous pulpy mass" appearing in the patent claims as allowed by the Patent Office properly includes Texas Star-O*

grease. The findings of the District Court on this issue are supported by considerable evidence in the record of this case (P. Br. 30-38) including a substantial amount of witness testimony given before the District Court. This Court's construction of the claims, and more specifically its limited interpretation of the meaning of "viscous pulpy mass" is contrary to the weight of the evidence. The record in this case requires an affirmance of the District Court on the question of infringement.

Conclusion.

It is respectfully submitted that for the foregoing reasons this petition for rehearing should be granted. The District Court gave careful attention to the witness testimony and other evidence introduced during four and one half days of trial. The District Court particularly and carefully questioned the witnesses with respect to the properties of follower material compositions and ball point pen inks (P. App. 11, 12, 15, 18, 21, 23, 31, 48, 50, 52, 53, 56, 58, 59, 87, 94, 110; D. App. 24, 25, 28, 29, 41, 56). Extensive briefs were filed by both sides before and after trial. The findings of fact are supported by the record and the specific findings relating to the meaning of "viscous pulpy" are supported by witness testimony. It is respectfully urged that this Court should not have substituted the views expressed in argument by defendant's counsel for the District Court's findings and the record evidence.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago 10, Illinois

I, KENNETH J. CARRICK, Clerk of the United States Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing ..... pages contain a true copy of The Appellees' "Petition for Rehearing", filed in this Court on January 31, 1964.

Cause No. 14070

ERNST JOHAN HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant

as the same remains upon the files and records of the United States Court of Appeals for the Seventh Circuit.

IN TESTIMONY WHEREOF I hereunto subscribe my name and affix the seal of said United States Court of Appeals for the Seventh Circuit, at the City of Chicago, this thirteenth day of May, A.D. 1964.

KENNETH J. CARRICK,
Clerk of the United States Court of Appeals for the Seventh Circuit.

By: Thomas F. Strubbe, *Deputy Clerk*

[SEAL]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 14070

ERNST JOHAN JENS HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

HONORABLE RICHARD B. AUSTIN,
Trial Judge.

Answer To Petition For Rehearing.

The petition for rehearing sets forth no ground supporting the decision of the District Court that was not previously presented in the briefs and oral arguments made before this Court.

The three points upon which the petition is based will be answered individually.

THE PETITION FOR REHEARING REQUESTS THIS COURT TO DISREGARD THE ELECTION MADE BY THE PATENTEE IN THE PATENT OFFICE.

The admitted and indisputable facts appearing from the documentary evidence in the record establish that, (i) the patentee Henriksen, in order to secure his patent, gave the term "pulpy" an interpretation which excluded "greasy", and he specifically pointed out that "pulpy" and "greasy" followers were different and distinct species,

(ii) he elected the "pulpy" species and limited all his claims to such a follower pursuant to Rule 41 of the Patent Office, which requires that after such election the patent which subsequently issues must be restricted to the elected species.

The petition for rehearing in effect requests this Court to overlook the proceedings had in the Patent Office, to disregard the election which the patentee himself made in order to get his patent allowed, and to view the case as though the election of species had never been made.

The public is entitled to rely upon the representations made and the positions taken by the patentee before the Patent Office in order to secure his patent. The authorities supporting this position are numerous and this Court's decision applying the doctrine of file wrapper estoppel was eminently sound.

THE PETITION FOR REHEARING, IN ARGUING THAT TEXAS STAR "O" GREASE IS PULPY, IS NOT SUPPORTED BY THE RECORD.

A further point presented in the petition for rehearing is to the effect that the Defendant's Texas Star "O" grease is pulpy. In the first place, in order for the Plaintiffs to take this position they must presuppose that the Court had accepted the argument discussed in the preceding section, namely, that this Court would disregard the proceedings in the Patent Office, particularly the patentee's classification of "pulpy" and "greasy" as being different species and his election under Rule 41 to restrict his patent to the elected "pulpy" species.

The fact remains, however, that even if the patentee himself had not defined "pulpy" as being exclusive of "greasy", Defendant's Texas Star "O" grease is not

pulpy. Three well qualified witnesses were asked the direct question of whether or not Texas Star "O" grease is pulpy. They each answered in the negative. (See Appellant's Brief, page 25.) The fact that this testimony was by way of deposition rather than "at the trial" does not detract from it. Dr. Miner, upon whose testimony Plaintiffs rely heavily, not only never stated that Texas Star "O" grease was "pulpy", he admitted by his own testimony that his experience in connection with greases were "only in the most general sense", and that his only specific experiment with grease was "quite vague in my mind". (P. App. 14.) In any event, the interpretations of "pulpy" and "greasy" given by Dr. Miner long after the patentee himself had defined the terms to the Patent Office, are irrelevant and need not be considered.

THE FINDINGS OF FACT ON WHICH THE DISTRICT COURT BASED ITS DECISION ARE UNSUPPORTED IN THE RECORD.

The petition for rehearing takes the position that this Court depreciated the findings of the trial court simply because they were prepared by Plaintiffs' counsel. The fact is that the points on which Defendant heavily relies in this appeal are to be found in the documentary portion of the record and any "depreciation" of the District Court's findings are clearly warranted, not simply because the findings were prepared by petitioner's counsel, but because they perpetrate an erroneous legal position which ignores certain controlling facts, documentary in nature, and undisputed as to authenticity.

Conclusion.

Petitioners have not shown that this Court has misapprehended, misconceived, or overlooked any material matter of fact or law. All of the reasons against granting a rehearing obtain in this case; no reasons exist in favor of a

rehearing. (See *e.g.* Louisell "Rehearing in American Appellate Courts" 25 F. R. D. 143, 1960.)

The petition should be denied.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Wednesday, February 26, 1964

Before

HON. JOHN S. HASTINGS, *Chief Judge*
HON. F. RYAN DUFFY, *Circuit Judge*
HON. LATHAM CASTLE, *Circuit Judge*

No. 14070

ERNST JOHAN JENS HENRIKSEN, *et al.*,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

IT IS ORDERED by the Court that the petition for a rehearing of this cause be, and the same is hereby, denied.

Office Supreme Court, U.S.
FILED
JUN 17 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 1050

ERNST JOHAN JENS HENRIKSEN AND
W. A. SHEAFFER PEN COMPANY,
Petitioners,

vs.

CORY CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

No. 1150.

ERNST JOHAN JENS HENRIKSEN AND
W. A. SHEAFFER PEN COMPANY,
Petitioners,

vs.

CORY CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no special or important reasons why certiorari should be granted in the present case. The Court of Appeals from whose decision review is sought, correctly applied the well established rule of law that a patentee having asserted in the Patent Office that his claims have one particular meaning in order to get them allowed, cannot take the position in court that the claims have a different and broader meaning. In arriving at this decision, the Court of Appeals relied upon principles established by this Court as early as 1900 in the case of *Hubbell* v. *United States,* 179 U. S. 77.

There is no conflict between the decision of the Court of Appeals below and the decision of the Court of Appeals

for the Ninth Circuit in the case of *Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347, as claimed by petitioners. In both decisions the Courts of Appeal recognize the rule that a file wrapper estoppel can arise out of actions taken by the patentee in the Patent Office in order to get his claims allowed, including the election of species.

The questions presented in the petition are based on a misreading of the facts in this case. Under the true facts of the case the questions disappear.

RESTATEMENT OF THE CASE.

Petitioners incorrectly represent (Pet. 5) that Henriksen was the originator of the concededly simple idea of using, in a ball point pen having a large diameter ink reservoir, a follower or lid on top of the ink column in order to keep the ink from running out when the pen is inverted and also to keep the ink from contact with the air. Such a construction using a cylindrical body of aluminum as the follower, is shown in the prior art Huenergardt patent 2,426,453 (Rec. 313). The Huenergardt patent is not discussed in the petition, although during the period from 1945 to 1949 about 150 million pens having the Huenergardt construction were sold in this country and abroad (Rec. 78-82).

In his application as originally filed, Henriksen stated that his lid or follower could take many forms, and his claims covered the use of followers broadly as well as various kinds of followers (Rec. 173, 180-187).

When the Huenergardt patent was cited by the Patent Office, Rule 41 requiring Henriksen to elect a species for prosecution was also cited (Rec. 194-5). Thereupon, Henriksen added three new claims, 28, 29 and 30 (Rec. 196-7). Claim 28 described the follower as being "a viscous mass",

claim 29 described it as "a layer of a greasy substance", and claim 30 described it as "a layer of a pulpy mass". In filing the three additional claims Henriksen stated that claim 28 was "indicative" of the species of the invention as then elected, and pointed out to the Patent Office that:

> "Claims 29 and 30 are directed to the species of a greasy substance and pulpy mass, **respectively**, as species to which claim 28 is generic." (Rec. 198.)*

Henriksen in the same amendment went on to state that in the event his "viscous" claim was not allowable, he elected the "pulpy" species, saying:

> "Applicant **further elects as a single species** for the lid a lid of **pulpy mass** in the event that no generic claim should be found allowable." (Rec. 198.)

It is undeniably clear as pointed out by the Court of Appeals below (Pet. 5a-6a), that Henriksen thus defined "pulpy" and "greasy" followers as separate and independent species under Rule 41, and different from each other. All of the claims in the Henriksen patent require the follower to be pulpy, whereas respondent's follower is common lubricating grease.

In the next Patent Office action the examiner rejected generic claim 28** as unpatentable over Huenergardt and other prior art (Rec. 200), and also stated:

> "Claim 29, **specific** to grease, and claim 30, **specific** to pulp, are rejected for reasons applied to claim 28." (*Ibid.*)

After Henriksen had re-argued these claims (Rec. 201-4), the examiner rejected them all again (Rec. 205-6), citing

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* All emphasis ours unless otherwise indicated.

** Petitioners incorrectly refer (Pet. 7, 8, 9) to claim 9 as "defining the follower generically", and to claims 28-30 as all "species" claims (Pet. 9, 18). Claim 9 was limited, as claims 28-30 were not, to a pen structure having an air tight chamber and a driving pressure on the follower (Rec. 182).

Martin patent 2,495,013 (Rec. 319). Martin discloses a ball point pen wherein the follower was a "highly viscous or pasty" slug of ink (Rec. 322). Furthermore, Martin stated that the ink could be of the types shown in several Biro patents, and the inks of those patents were greasy.*

After the Patent Office cited the Martin patent Henriksen cancelled all of his prior claims and presented claim 31 wherein the follower was described as a "substantially viscous **pulpy** mass" (Rec. 207-209). In substituting claim 31 for all of the claims theretofore in the case, Henriksen stated, in support of alleged patentability thereof over Martin:

> "Such structure is believed **entirely different** from that of applicant as now set forth in new claim 31 **which is drawn to the elected species.**
>
> "As soon as this claim is considered allowable, applicant will **in accordance with his election made,** change Fig. 2 to show a **follower of pulpy mass** for the follower 6 as now indicated in Fig. 2." (Rec. 208-209.)

The foregoing action taken by Henriksen, and his acquiescence in the issuance of his patent with all claims restricted to the "pulpy" follower, establishes a clear basis for the determination by the Court of Appeals that

> "Henriksen clearly abandoned a 'greasy' follower and limited his patent to the 'elected species' where the follower is 'pulpy.'" (Pet. 6a.)

Even with claim 31 limited to a pulpy follower, the examiner refused to allow it (Rec. 210). On Henriksen's appeal to the Board of Appeals, only the Martin patent was relied on by the examiner in arguing that **"the elected species 'pulpy mass'** follower" was unpatentable

* The Biro patents appeared in the record below as part of the 317 page printed Appendix filed by the petitioners (then Plaintiffs-Appellees). This Appendix, however, was omitted by the petitioners from the record filed in this Court, although Rule 21(3) would seem to require it. See also Rule 22(3).

(Rec. 225). The Board allowed the claim on the ground that Martin failed to show a large capacity reservoir (Rec. 233). The Huenergardt patent, of course, does show a large capacity reservoir but the examiner had failed to cite this patent to the Board on the appeal.

After the decision of the Board of Appeals, the specification was revised, and in its discussion of the follower stated among other things that it could consist of

> "a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils), **or** of wax, **or** of a viscous pulpy mass . . ." (Rec. 237-238.)

Petitioners' argument (Pet. 10, 19), that this latter statement defined "pulpy" to include the other materials described, completely overlooks the disjunctive "or." Thus, anyone looking at this language in the specification for a definition of "viscous pulpy mass" as used in the claims, would see only that it was something other than wax or paraffin compositions. Compare Rec. 225. Henriksen had earlier stated that nonelected divisional subject matter was being retained in the case (Rec. 198) and perhaps the examiner viewed these other compositions (if he noted their presence at all) as pertinent to the "divisional applications on other species" Henriksen said he might file, and which he later did file.* In any event, petitioners' assertion (Pet. 10, 18-19, 24) that the examiner "agreed" with Henriksen that the revised specification changed the prior scope of the allowed claims is palpably wrong.

Also wrong are petitioners' assertions (Pet. 10-11, 18-21, 24) that the scope of the elected "pulpy mass" claims was changed by Henriksen's last minute remarks regarding followers of "cup-grease" and thickened "mineral oil" (Rec. 249), and that the examiner "approved",

* Such an application was filed on April 8, 1954 (Rec. 114).

"agreed to" and "officially accepted" this alleged change. The remarks referred to appear in an amendment filed March 4, 1954 following an interview with the examiner. We do not know what attempts Henriksen's attorney may have made at this interview to try to get the examiner's approval to a proposed claim which was not restricted to the previously elected "pulpy" species. But, clearly, he was unsuccessful since new claim 34 was also so restricted. Henriksen's remarks do **not** say that cup-grease and thickened mineral oil are "pulpy mass" followers, merely that they are types of "viscous" followers. This is entirely consistent with the position he took when he originally introduced the generic "viscous" claim and the independent "greasy" and "pulpy" species claims. The examiner undoubtedly so viewed the remarks. In any event, the law is clear as noted *infra*, p. 9, that such remarks by an applicant, unaccompanied by appropriate changes in the wording of his claims, cannot affect a prior disclaimer. Henriksen **did not** change the elected "pulpy mass" restriction in his claims and **did not** appeal from the rejection of claims to the different "greasy substance" species and to "viscous" followers generally.

The foregoing clearly refutes the erroneous factual basis for petitioners' "questions presented" and "reasons for granting the writ". The election by Henriksen was not a "provisional, contingent" one which was later "withdrawn, modified or annulled". And the prosecution history subsequent to that election not only fails to reveal any "agreement" between Henriksen and the examiner to change the elected "pulpy mass" limitation in his claims, but instead confirms and reinforces that limitation. The Court of Appeals did not ignore that subsequent history, it merely interpreted it correctly.

NO REASON EXISTS HERE FOR GRANTING CERTIORARI.

When the controlling facts of this case are stated accurately, it is readily seen that the only real question presented here is whether petitioners, defeated below, are entitled to another hearing on the merits of their case. But as stated in *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923), certiorari jurisdiction

> "was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing".

Also, when the controlling facts here are stated accurately, it is readily seen that the Court of Appeals holding of non-infringement was correct, under well established principles of law. See e.g., *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 443-444 (1926), *Smith* v. *Magic City Club*, 282 U. S. 784, 789-790 (1931), *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 220-221 (1940), *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. U. S. 126, 136-137 (1942).

Furthermore, on the facts here *none* of the cases cited in the petition supports a holding contrary to that below. Indeed, in many of those cases, the courts, on similar facts, held to the same effect, enouncing principles identical to, or in harmony with, those applied in this case.* Cases cited by petitioners dealing with alleged constitu-

* See, in addition to the cases cited at Pet. 14, *Leggett* v. *Avery*, 101 U. S. 256, 259-260 (1879), *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, 429 (1894), both cited at Pet. 18, *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 443-444 (1926), *Hookless Fastener Co.* v. *G. E. Prentice Mfg. Co.*, 68 F. 2d 848, 850 (2 Cir. 1934), *Del Francia* v. *Stanthony Corporation*, 278 F. 2d 745, 747 (9 Cir. 1960), *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938), *Zenith Radio Corp.* v. *Lehman*, 121 F. Supp 69, 73 (S. D. N. Y. 1954), affirmed per curiam 217 F. 2d 954 (2 Cir. 1955), *Directoplate Corp.* v. *Donaldson Lithographing Co.*, 51 F. 2d 199, 202 (6 Cir. 1931), all cited at Pet. 20-21, *Dwight & Lloyd Sintering Co.* v. *Greenawalt*, 27 F. 2d 823, 832 (2 Cir. 1928), cited at Pet. 24, 30, and *Westinghouse Electric Corp.* v. *Hanovia Chem. & Mfg. Co.*, 179 F. 2d 293, 296-297 (3 Cir. 1949), cited at Pet. 24.

tional issues need not be discussed by us because those issues do not arise on the facts here.*

As to the petition's alleged "conflict" between the Court of Appeals opinion below and the opinion in *Englehard Industries, Inc.* v. *Research Instrumental Corp.*, 324 F. 2d 347 (9 Cir. 1963) this too disappears when the facts here are correctly viewed, even apart from (a) the fact that the court in *Englehard* held non-infringement on another ground, and (b) the fact that the *Englehard* decision was not "on the same matter" as the present case, since that case involved an entirely different patent.**

In *Englehard*, the facts were significantly different from those here. There, after the examiner had made an interpretation of the wording of elected claims **the applicant did not acquiesce in that interpretation; if he had, the Court indicated he would later have been estopped to argue a different interpretation** (Ibid.). Instead, the applicant "broadened" the language of his claims in new claims, "both specific **and generic**", with which he replaced the old. Also, the non-elected species did not correspond precisely to the accused device.

Petitioners argue (Pet. 13-15) that procedural Patent Office requirements, such as requirements for election of species, cannot give rise to a file wrapper estoppel; they say "substantive" rejections are required. Here, of course, Henriksen's cancellation of his generic and "greasy" claims followed a clearly "substantive" rejection on the prior art, so petitioner's argument is inapposite. But that

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* Some of the cases so cited are inapposite, in any event, to civil cases such as patent infringement actions. See e.g., *Levy Leasing Co.* v. *Siegel*, 258 U. S. 242, 250 (1922), *Mahler* v. *Eby*, 264 U. S. 32, 41 (1934) and *Fahey* v. *Mallance*, 332 U. S. 245, 250 (1946), all distinguishing *United States* v. *Cohen Grocery Co.*, 255 U. S. 81, 91 (1921), cited at Pet. 28.

** This Court's Rule 19(1)(b) refers to conflicts between decisions of Courts of Appeals "on the same matter." See *Keller* v. *Adams-Campbell Co.*, 264 U.S. 314, 319 (1924).

argument is also wrong, in reason and logic, and there are cases to the contrary. See e.g., *Higgin Mfg. Co.* v. *Watson*, 263 Fed. 378 (6 Cir. 1920), *Carter Products, Inc.* v. *Colgate-Palmolive Company*, 269 F. 2d 299 (4 Cir. 1959), *Macbeth* v. *Gillinder*, 54 Fed. 169 (C. C. E. D. Pa. 1889), *Speakman Company* v. *Sloan Valve Company*, 166 F. Supp. 877 (E. D. Pa. 1958).

It has also been a long-established rule that Henriksen's last minute remarks about "grease", unaccompanied by any broadening of the wording of claims previously restricted to the different "pulpy" species, cannot affect his prior disclaimer of greasy followers. See e.g., *Thomas* v. *Rocker Spring Co.*, 77 Fed. 420, 431-2 (6 Cir. 1896), cert. denied 168 U. S. 709 (1897), *Johnson Furnace & Engineering Co.* v. *Western Furnace Co.*, 178 Fed. 819, 824 (8 Cir. 1910), *Parke, Davis & Co.* v. *American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953).

Henriksen was, indeed, "his own lexicographer" (Pet. 21). He distinguished "pulpy mass" and "greasy substance" followers, cancelled a claim to the latter and limited his claims to the former in order to get them allowed, and acquiesced in the issuance of his patent with all claims so restricted. The Court of Appeals correctly held that the "pulpy mass" of the patent claims cannot be interpreted to include a "greasy substance".

CONCLUSION.

The petition should be denied.

Respectfully submitted,

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IN THE

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OCTOBER TERM, 1963

No. [redacted] 118

ERNST JOHAN JENS HENRIKSEN and W. A. SHEAFFER PEN COMPANY, *Petitioners*

v.

CORY CORPORATION, *Respondent*

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

Under no circumstances do Petitioners seek certiorari here in order to have "another hearing on the merits of their case". (Resp. Brief page 7).

To the contrary, the Petition raises three questions only: (1) the constitutionality of Patent Office Rule 41, the sole foundation for the alleged file-wrapper estoppel (Pet. pages 14-7, 27-30); (2) the power and competence of any court to overrule an agreement between an applicant and the Patent Office as to the meaning of the technical terms of art used in a patent application (Pet. pages 23-5); (3) the constitutionality and validity of the novel theory of file-wrapper estoppel invoked *sua sponte* by the Court of Appeals, which

strikes at the heart of the patent system. (Pet. pages 13-4, 17-23, 26-30)

Respondent's Brief is conspicuously silent on all three of these issues. It seeks to "restate" the facts (Resp. Brief pages 2 to 6) in an unsuccessful effort to exclude the questions posed by the Petition. It asserts baldly that the Court of Appeals was correct on file-wrapper estoppel. It gives this Court no assistance on the only questions raised in the Petition.

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